



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/502,264

07/22/2004

Kazuhiro Namba

F-8340

9425

28107 7590 04/11/2007  
JORDAN AND HAMBURG LLP  
122 EAST 42ND STREET  
SUITE 4000  
NEW YORK, NY 10168

EXAMINER

NGUYEN, KIM T

ART UNIT

PAPER NUMBER

3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

04/11/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

14

<b>Office Action Summary</b>	<b>Application No.</b> 10/502,264	<b>Applicant(s)</b> NAMBA ET AL.	
	<b>Examiner</b> Kim T. Nguyen	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 17-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- 1. ☒ Certified copies of the priority documents have been received.
  - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/18/06</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The amendment filed on 1/19/07 has been entered. By this amendment, claims 13-31 have been added, and claims 1-31 are now pending in the application. Since claims 1-31 are subjected to a restriction requirement, claims 1-16 are examined in this office action, and claims 17-31 are withdrawn from consideration as being directed to a non-elected invention.

### ***Election/Restrictions***

1. Newly submitted claims 17-31 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 17-31 are directed to performing functions associated with various input operations by a programmable device which is distinct from the originally claimed claims 1-12 that direct to executing a manipulation suppression program.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 17-31 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Objections***

2. Claim 4 is objected to because of the following informalities:

In claim 4, line 4, the claimed limitation “predetermined manipulation suppression program” should be corrected to “manipulation suppression program”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) In claim 1, lines 1-5, the preamble "A recording medium having ... as a video game machine comprising" is ambiguous. It is unclear from the claim whether applicant has intended to claim a recording medium or a video game machine. If claim 1 is directed to a recording medium, the claim "A recording medium ... comprising: a detecting means ..., and an executing means..." will be rejected under 112-first paragraph as failing to comply with the written description requirement. The claim contains new subject matter, which was not described in the specification. Further, a recording medium is a storage device used for storing data or program codes. How could a storage medium comprise physical elements such as detecting means or executing means?

b) Claim 4 is similarly rejected as explained in claim 1 above.

c) Claims 2-3 and 5-10 and 14-16 are rejected as being dependent on the rejected base claim.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make

Art Unit: 3714

and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 13-14 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added claims 13-14 and 16 contain new matter. In particular, the disclosure as originally filed does not disclose the predetermined manipulation unnecessary adversely affects a life span of the input device of the programmable device set forth in claims 13 and 14; and the predetermined manipulation adversely affecting a life span of the programmable device set forth in claim 16.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**8. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori (U.S. Publication No. 2003/0073473) in view of Hiroshi et al (JP 11-114225).**

Re claim 1: Mori discloses a recording medium having stored thereon in executable form a manipulation suppression program which is used to suppress a

predetermined manipulation by a user wherein the predetermined manipulation suppression program is configured so as to control a programmable device having an input device and display to function as a video game machine comprising an executing means, responsive to the predetermined manipulation being detected, executing a predetermined suppression operation which suppresses the predetermined manipulation of the user based on the predetermined manipulation being detected (paragraph 0026). Mori does not explicitly disclose a detecting means for detecting the predetermined manipulation of the input device by the user wherein the predetermined manipulation adversely affects the input device of the programmable device. However, Mori discloses that the CPU executes a operation that adversely affects the input device of the programmable device (paragraph 0026). Hiroshi discloses a detecting means for detecting the predetermined manipulation of the input device by the user (paragraph 0009 and 0011). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the detection device as taught by Hiroshi to the game system of Mori in order to stop the player from manipulating an inhibit act.

Re claim 2: Hiroshi discloses wherein the executing means includes a presenting means for presenting suppression information to the user as the predetermined suppression operation to suppress the predetermined manipulation by the user (paragraph 0036).

Re claim 3: Hiroshi discloses wherein the suppression information includes a suppression picture provided to the display which conveys a message to suppress the

predetermined manipulation by the user (e.g. displaying in a display 5 an alarm apart from an alarm) (paragraph 0036).

Re claim 4: since claim 4 discloses the same subject matter cited in claim 1, claim 4 is similarly rejected as explained in claim 1 above.

Re claim 5: since claim 5 discloses the same subject matter cited in claim 2, claim 5 is similarly rejected as explained in claim 2 above.

Re claim 6: since claim 6 discloses the same subject matter cited in claim 3, claim 6 is similarly rejected as explained in claim 3 above.

Re claim 7: Mori discloses wherein the executing means includes a game-situation changing means for changing a game situation of the game (paragraph 0026).

Re claim 8: Mori discloses wherein the game-situation changing means changes a parameter (e.g. parameter from the vehicle speed) which corresponds to a character who appears in the game (paragraph 0022).

Re claim 9: Mori and Hiroshi fail to disclose a game terminating means for terminating the game in response to the predetermined manipulation being detected by the detecting means. However, terminating a game forcedly if a predetermined number of inhibited act are detected would have been obvious to a person of ordinary skill in the art at the time the invention was made. One of ordinary skill in the art would have found it obvious to add the old and well-known game terminating means to the system of Mori and Hiroshi in order to stop the game when the player violates the rules of the game.

Re claim 10: since claim 10 discloses the same subject matter cited in claim 9, claim 10 is similarly rejected as explained in claim 9 above.

Re claim 11: since claim 11 discloses the same subject matter cited in claim 1, claim 11 is similarly rejected as explained in claim 1 above.

Re claim 12: since claim 12 discloses the same subject matter cited in claim 1, claim 12 is similarly rejected as explained in claim 1 above.

Re claim 13: since Mori discloses adversely affecting the input device over a specific time period (lines 10-12 of claim 8), Mori obviously encompasses unnecessary adversely affects a life span of the input device as claimed.

Re claim 14: since claim 14 discloses the same subject matter cited in claims 13 and 7-8, claim 14 is similarly rejected as explained in claims 13 and 7-8 above.

#### ***Allowable Subject Matter***

9. Claims 15-16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

10. Applicant's arguments filed 1/19/07 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



Art Unit: 3714

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(571) 273-8300, (for formal communications; please mark  
"EXPEDITED PROCEDURE")

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim T. Nguyen whose telephone number is (571) 272-4441. The examiner can normally be reached on Monday-Thursday from 8:30AM to 5:00PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on (571) 272-7147. The central official fax number is (571) 273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kn

Date: March 30, 2007



Kim T. Nguyen  
Primary Examiner  
Art Unit 3714